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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,906	06/07/2007	Bernd Jung	0070681-000034	2365

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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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05/03/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/560,906	Applicant(s) JUNG ET AL.	
	Examiner MARC S. ZIMMER	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozai et al., U.S. Patent Application Publication No. 2003/0220448.

Ozai discloses a hydrosilylation-curable polysiloxane composition comprising a preferably linear polyorganosiloxane corresponding to claimed component (B) bearing at least two alkenyl groups with viscosity range that is fully encompassed by the claimed ranges, an organohydrogensiloxane (B) corresponding to claimed component (A) of which two permutations are a dimethylhydrogensiloxy-endcapped diomethylpolysiloxane or dimethylsiloxane/methylhydrogensiloxane copolymer, and a platinum catalyst (C). See paragraphs [0013-0016 and 0020-0023]. The ratio of hydrosilyl groups contributed by the organohydrogensiloxane to vinyl groups contributed by the alkenyl group-substituted polysiloxane is preferably 0.8 to 2.0.

Relevant to the present discussion, it is contemplated in [0017] that an organopolysiloxane bearing only a single alkenyl group may be incorporated so as to adjust the hardness of the elastomer product. There is no indication as to where the alkenyl substituent is to be positioned and, thus, it is the Examiner's position that embodiments of this component where the alkenyl moiety may be found at a terminal or interior position alike would be immediately envisaged. As for the requirement

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concerning the amount of T unit content, the preferred structure of the alkenyl-substituted polyorganosiloxane is linear- see paragraph [0015]- and, to the extent that the disclosure is not forthcoming as to the structure of the fraction of component (A), or claimed component (B), that contains only a single alkenyl group, the skilled artisan will appreciate that it should possess the same linear geometry as do the favored alkenyl-functional siloxanes that contain a plurality of alkenyl groups.

As for claim 16, Ozai appears only to contemplate a non-part composition but it is the Examiner's contention that a two-part composition is always obvious where a curable one-part composition is described and that composition may be susceptible to premature curing as is known to occur with hydrosilylation-curable compositions under ambient conditions. (Applicant disputed this position when traversing the rejection over Ikeno. While it may be true that the prior art advocates curing at temperature significantly higher than ambient in paragraph [0034], this does not mean that curing will not occur at temperatures under which these compositions occurs albeit at a proportionally slower rate. In fact, It is conventional in the prior art to add inhibitors to preclude premature curing but the problem with their addition often is either that they are not effective enough as to completely prevent curing in storage or, alternatively, they are so effective as to limit curing even at elevated temperatures when it eventually becomes desirable to promote curing. Hence, one way of avoiding these problems is to simply formulate the composition as two parts where not all of the base polymer, crosslinker, and catalyst are formulated into the same part.

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Concerning claims 17-19, there is not yet a clear distinction between the claimed invention and that of prior art invention where it contains the organopolysiloxane with a single alkenyl group and, therefore, the latter is regarded as inherently possessing adhesive properties.

As an aside, the Examiner considered the matter of whether or not the original disclosure may have outlined some unexpected property associated with the inclusion of POS(III). The problem is, the Specification is so utterly devoid of any description of the makeup of the composition of the comparative example that it is impossible to ascertain to what one of ordinary skill might attribute the differences in performance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

April 26, 2010

/Marc S. Zimmer/
Primary Examiner, Art Unit 1796